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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,696	12/20/2001	Missy L. Villapudua	020375-003100US	4166
20350	7590	12/30/2004	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			WOO, RICHARD SUKYOON	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/027,696

Applicant(s)

VILLAPUDUA, MISSY L

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 20, 2004 has been entered.

### ***Claim Objections***

2) Claims 1-10 are objected to because of the following informalities:

In Claim 1, line 6, "and" should be deleted.

In Claim 1, line 13, --and-- should be inserted after “.”.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4) Claims 1-10 and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Walter (US 2002/0087472).

**W.R.T. Claim 1:**

Walter discloses a method for protecting consumer personal data, comprising:  
receiving an application for a payment instrument (e.g. smart card or loyalty card in Fig. 3), wherein the application comprises personal data and a privacy preference of a consumer (see paragraph [0045], see Fig. 4);

saving the application in a database (see Figs. 1 and 5) that is associated with an issuing financial institution who issued the payment instrument (see paragraph [0044] for the inherent financial institution, which is issuing the card); and

storing at least some of the personal data and the privacy preference onto the payment instrument, wherein the payment instrument includes consumer account information necessary to tie a debit or credit payment transaction to a consumer account that is associated with the issuing financial institution (see paragraphs [0025], [0036]-[0038]);

receiving a purchase request at a credit or debit processing system that is associated with a merchant financial institution, wherein the purchase request includes at least some of the personal data and the privacy preference (see paragraphs [0012]-[0013], [0036]-[0038], [0040], [0044]); and

saving the privacy preference in a database associated with the merchant financial institution (28) (see Id.).

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W.R.T. Claims 2 and 4: Walter also discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card) (see Supra paragraphs);

W.R.T. Claim 3: Walter further discloses the method, wherein the payment instrument includes a check, and wherein the privacy preference is printed onto the check (see Supra paragraph [0025]);

W.R.T. Claim 5: Walter also discloses the method including the step of reading the personal data and the preference at a merchant location when the consumer's payment instrument is accessed, and saving the data at the merchant storage location (see paragraphs [0012]-[0013], [0036]-[0038], [0040], [0044]);

W.R.T. Claim 6: Walter also discloses the method including the step of mailing marketing material to the consumer only if permitted by the consumer's privacy preference (see paragraph [0003]);

W.R.T. Claims 7-8: Walter also discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from affiliated merchants (see paragraphs [0003], [0006] by controlling the type of personal data that may be collected);

W.R.T. Claim 9: Walter also discloses the method, wherein the privacy preference indicates that consumer receives marketing material only from the affiliated bank (*Id.*); and

W.R.T. Claim 10: Walter also discloses the method, wherein the privacy preference indicates that the consumer opts out (see paragraph [0008]).

**W.R.T. Claim 13:**

Walter discloses a method for protecting consumer personal data, comprising:  
providing the consumer with a payment instrument (smart card) having stored thereon a privacy preference, wherein the payment instrument further includes consumer account information necessary to tie or credit payment transaction to a consumer account (see paragraphs [0025], [0036]-[0038]);

reading the privacy preference from the payment instrument when making a purchase at a merchant location, wherein the consumer account information is read to provide payment to a merchant (see Id.);

saving the application in a merchant database (see paragraphs [0012]-[0013], [0036]-[0038], [0040], [0044] and abstract); and

contacting the consumer in accordance with the privacy preference (see Supra Claims 6-9; the consumer controls what types of information that may be used).

W.R.T. Claims 14 and 16: Walter also discloses the method, wherein the payment instrument comprises a credit or debit card having a magnetic stripe, or a processor and memory (smart card) (see Supra paragraph [0025]); and

W.R.T. Claim 15: Walter further discloses the method, wherein the payment instrument includes a check, and wherein the privacy preference is printed onto the check (see Supra paragraph [0025]).

**Conclusion**

5) The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

"Providian Helps Set Benchmark for Smart Card Industry" is cited to show a smart chip cards that delivers enhanced access, electronic payment and storage capabilities to cardholders and a platform for future merchant loyalty program. (available at <http://home.providian.com/Press-Releases/06-12-2001.htm>)

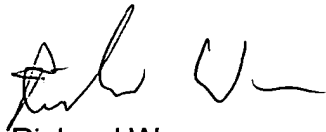
"Millions Served: Java Card Technology" is cited to show a java card technology that provides a post-issuance feature, where applications can be securely loaded after the cards are issued, allowing card issuers to dynamically respond to their customer's personal preferences as they arise (available at <http://java.sun.com/features/2001/05/cardtech.html>).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

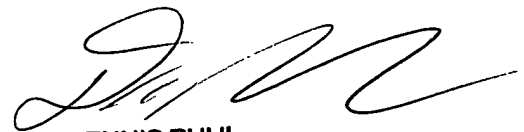
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo  
Patent Examiner  
Art Unit 3629  
December 23, 2004



DENNIS RUHL  
PRIMARY EXAMINER